

REMARKS

Claims 1 and 3-37 are pending in the patent application. Claims 34-37 have been added.

Claim 1 is amended herein to correct a spelling error and overcome the objection thereover. Reconsideration and withdrawal of the objection is requested.

1. THE 35 U.S.C. § 102 REJECTION

Claims 1, 3, 4, 8-11, 15-19, 23-27 and 31-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by **Inoue** (U.S. Pat. No. 5,752,881). This rejection is respectfully traversed.

The Examiner alleges **Inoue** discloses a reel having components with two velocities (citing Fig. 2, col. 6, line 55). The Examiner contends that, based on this disclosure, the “outer portion has the discrete symbols and the inner portion is a continuous graphical element.”

Under the law of anticipation, “[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the . . . claim”. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicant submits that **Inoue** does not teach (or suggest) a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element (claims 1, 18) or a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element (claims 9, 25).

Inoue’s teaching of a reel (e.g., 6) comprising an outer reel (e.g., 17) and an inner reel (e.g., 18), as shown in FIG. 2, is factually insufficient to anticipate the independent claims 1, 9, 18 and 25, or claims depending therefrom. The alleged continuous graphical element (i.e., the

graphics on the inner reels) does not extend between adjacent ones of the discrete symbols *such that the discrete symbols are unified by the graphical element*, as required by independent claims 1 and 18, and does not extend between adjacent ones of the discrete symbol positions *such that the discrete symbol positions are unified by the graphical element*, as required by independent claims 9 and 25. Instead, as shown in FIG. 7 of **Inoue**, the graphical elements on reels 18, 22, and 23, displayed in positions 19a, 19b, and 19c behind discrete symbol positions centered in windows 3, 4 and 5, respectively, do not extend between adjacent ones of the discrete symbols *such that the discrete symbol positions are unified by the graphical element*. Thus, looking at the rightmost reel 8 in FIG. 7, the alleged continuous graphical element 19a does not extend between adjacent ones of the discrete symbols (*e.g.*, the BAR symbol(s) above and below) *such that the discrete symbol positions (e.g., the BAR symbols and the “7” symbol) are unified by the graphical element*. **Inoue** neither teaches nor suggests unification of the discrete symbols or of the discrete symbol positions in the manner claimed.

To the extent that the Examiner might consider or assert that **Inoue** teaches or suggests the claimed unification of the discrete symbols or of the discrete symbol positions by the graphical element, it is submitted that such interpretation of the claim language would be impermissibly broad. First, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (*stating “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered”*); *see also* MPEP §§ 706.02; 2142; 2143; 2143.03. Second, claims must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ (Fed. Cir. 1983). The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the

interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’*.” *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983)(italics added).

It is submitted that one of ordinary skill in the art would not have reasonably interpreted the above noted claim language, in light of the specification, as being anticipated by or obvious over the nested reel configuration of **Inoue**. **Inoue** does not teach or suggest, for example, a continuous graphical element extending between adjacent ones of the discrete symbols *such that the discrete symbols are unified by the graphical element*, such as shown by way of example in FIGS. 3-8 of Applicant’s application. FIGS. 3-6 shows “a plurality of discrete symbols 60 and a continuous graphical element 62 extending between adjacent ones of the discrete symbols 60 such that the discrete symbols 60 are unified by the graphical element 62” (see par. [0014] of application). **Inoue** contains no teaching or suggestion of unification of the discrete symbols by the graphical element, such as disclosed and claimed by Applicant.

It is therefore submitted that claims 1, 3, 4, 8-11, 15-19, 23-27, and 31-33 are not anticipated under 35 U.S.C. § 102 by (or obvious over) **Inoue** in view of the above remarks. Reconsideration and withdrawal of this rejection is requested.

2. THE 35 U.S.C. § 103 REJECTION

Claims 5-7, 12-14, 20-22 and 27-30 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over **Inoue**. This rejection is traversed.

A. PROFFERED MOTIVATION TO MODIFY INOUE INSUFFICIENT

As to claims 5, 6, 12, 13, 20, 21, 28 and 29, the Examiner alleges that it would have been “an obvious design choice to one of ordinary skill in this art to provide a particular theme for a

particular slot machine; in order to fulfill a customer's preference or tastes or the like". The Examiner further states that, "[a]bsent a showing of criticality, it is obvious to one of ordinary skill in the art to convert a stepper motor slot machine into a video slot machine" on the bases that "[b]oth are deemed art recognized equivalents in this art".

The courts have upheld obviousness findings based on the doctrine of "obvious design choice" in cases such as *In re Japikse*,¹ wherein claims to a power press which read on the prior art except with regard to the position of the starting switch (held unpatentable because shifting the position of the starting switch would not have modified the operation of the device) and *In re Kuhle*,² (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). The courts have also cautioned, however, that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Instead, "[t]he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." In this case, the claim elements at issue are not mere thematic trappings, but rather constitute elements that affect and form a part of the game play experience (*see, e.g.*, FIGS. 3-8 and corresponding disclosure). Additionally, the routine and minor modifications noted in *In re Japiske* and *In re Kuhle* can hardly be said to be comparable to the design effort that must be expended to design a wagering game that is successful. Divining, anticipating, and meeting a customer's preference or tastes is not akin to moving a switch from one position to another position or moving a contact

¹ 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

² 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

from one position to another position. Instead, it is a time-consuming, difficult endeavor taking a great many people a very long time to invent, develop, and bring to market such products. It is accordingly submitted that the Examiner's reliance on "obvious design choice" as a basis underpinning the 35 U.S.C. § 103 obviousness rejection is improper.

The question of whether a claim limitation may be within the level of ordinary skill in the art, whether such assertion is explicit or implied, is not a sufficient basis for concluding that the claimed subject matter would have been obvious under 35 U.S.C. § 103. That which is or may be within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). Indeed, it is well settled that there must be some motivation that would have led one of ordinary skill in the art to modify the prior art reference (in this case, **Inoue**) to arrive at the claimed invention. *See, e.g., B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *Al-site Corp. v. VSHnt 7 Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000).

B. INOUE FAILS TO TEACH OR SUGGEST EVERY ELEMENT OF CLAIMS

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. As noted above, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson, supra*.

Applicant submits that **Inoue** does not teach or suggest a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element (claims 1, 18) or a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element (claims 9, 25), as shown by way of example in the

specification (*see, e.g.*, FIGS. 3-8 and corresponding disclosure). **Inoue's** teaching of a reel (*e.g.*, 6) comprising an outer reel (*e.g.*, 17) and an inner reel (*e.g.*, 18), as shown in FIG. 2, is factually and legally insufficient to render obvious the independent claims 1, 9, 18 and 25, or claims depending therefrom (*i.e.*, here claims 5-7, 12-14, 20-22 and 27-30). The alleged continuous graphical element (*i.e.*, the graphics on the inner reels) does not extend between adjacent ones of the discrete symbols *such that the discrete symbols are unified by the graphical element*, as required by independent claims 1 and 18, and does not extend between adjacent ones of the discrete symbol positions *such that the discrete symbol positions are unified by the graphical element*, as required by independent claims 9 and 25. Instead, as shown in FIG. 7, the graphical elements on reels 18, 22, and 23, displayed in positions 19a, 19b, and 19c behind discrete symbol positions centered in windows 3, 4 and 5, respectively, do not extend between adjacent ones of the discrete symbols *such that the discrete symbol positions are unified by the graphical element*. Thus, looking at the rightmost reel 8 in FIG. 7, the alleged continuous graphical element 19a does not extend between adjacent ones of the discrete symbols (*e.g.*, the BAR symbol(s) above and below) *such that the discrete symbol positions (e.g., the BAR symbols and the "7" symbol) are unified by the graphical element*.

Inoue does not suggest, *as a whole*, unification of the discrete symbols or of the discrete symbol positions in the manner claimed and disclosed by Applicant. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Here, the operation of **Inoue's** reel sets 6-8 using an inner reel bearing a graphical element is not suggestive of the distinct configuration of the claimed reel or of the mode of

operation of the claimed reel. For example, whereas the characteristics of the graphical element (*i.e.*, inner reel) in **Inoue** are focused on the center line of the display to, in effect, have a second payline superimposed on top of a first payline, the disclosed embodiments of the claimed reel of the present invention show that the continuous graphical element of the claimed reel alters a visual aspect of the reels in a vertical direction of the reel so as to unify the discrete symbols or discrete symbol positions to provide a new aspect to game play, as disclosed. This is completely different from the construction of and mode of operation of the inner reels of **Inoue** relative to the outer reels.

In view of the above, it is respectfully submitted that the Examiner has not set forth a *prima facie* case of obviousness for want of the requisite factual basis. The factual showing must be clear and particular. See, *e.g.*, *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *CR. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). It is submitted that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged.

3. THE NEWLY ADDED CLAIMS

As to the newly added claims 34-37, which variously recite that the rotatable reel is only a single reel, **Inoue** does not identically teach "a single reel" bearing both a plurality of discrete symbols and a continuous graphical element. Instead, **Inoue** teaches a first reel set 6-8, each of the reel sets including an outer reel and an inner reel (see, *e.g.*, col. 3, line 62 to col. 4, line 15). In FIG. 3A of **Inoue**, "[a]n inner reel 18 is shown disposed inside the outer reel 17" (col. 4, lines 22-23). Thus, teaches only a set of reels, with an outer reel having discrete symbols and another reel, disposed inside of the outer reel, having the alleged graphical elements. Thus the multiple reels employed by **Inoue** fail to identically teach every element of claims 34-37.

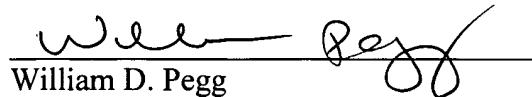
Further, **Inoue** does not teach or suggest “a single reel” bearing both a plurality of discrete symbols and a continuous graphical element. Instead, **Inoue** teaches a first reel set 6-8, each of the reel sets including an outer reel and an inner reel (see, e.g., col. 3, line 62 to col. 4, line 15). In FIG. 3A of **Inoue**, “[a]n inner reel 18 is shown disposed inside the outer reel 17” (col. 4, lines 22-23). Thus, teaches only a set of reels, with an outer reel having discrete symbols and another reel, disposed inside of the outer reel, having the alleged graphical elements. To the extent that the Examiner would take the position that the function of the graphical element in **Inoue** is the same as or suggestive of that disclosed by Applicant, Applicant would oppose such position as the omission of an element and retention of its function is an indicia of non-obviousness that must be weighed. *In re Edge*, 359 F.2d 896 (CCPA 1966).

4. CONCLUSION

It is the Applicant's belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested.

A check in the amount of \$200.00 is enclosed for the new claims added. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00119USPT.

Respectfully submitted,



William D. Pegg
Reg. No. 42,988
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-3900 – Telephone
(312) 425-3909 – Facsimile

Attorneys for Applicants